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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,009	08/09/2001	Pankaj Vinubhai Shah	A01098A	4173

7590 02/24/2004
Ronald D. Bakule
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100 Independence Mall West
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EXAMINER

GOFF II, JOHN L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/927,009

Applicant(s)

SHAH, PANKAJ VINUBHAI

Examiner

John L. Goff

Art Unit

1733

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-4.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


JEFF H. AFTERGUT
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GROUP 1300

09/92/009

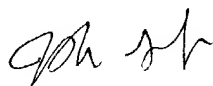
Continuation of 5. does NOT place the application in condition for allowance because:


Applicant argues "The examiner rejected claims 1-3 under 35 USC 102(e) as being anticipated by Graham. The examiner points to certain elements in Graham but concedes that Graham does not disclose admixing second components including the hydroxyl-functional prepolymer, a crystalline polyester polyol, and a polyisocyanate, the weight ratio of the hydroxyl-functional prepolymer to the polyol being from 9/1 to 1/9. Further, claim 1 (and claims 2-3 which depend therefrom) recites the polyol of the first components as having a weight average molecular weight of from 250 to 5,000. Graham's disclosures do not provide applicant's invention of claims 1-3 with a sufficient degree of specificity to represent anticipation under 35 USC 102(e)." It is noted the Examiner responded to these arguments in the previous Office Action (See paragraph 5).

Applicant further argues "Further, the examiner points to Example 2 of Graham as illustrative of an anticipating weight ratio of hydroxyl-functional polymer to polyol; applicants respectfully point out, however, that the polyol used in the first step of Graham's Example 2, DYNACOLL 7361, is indicated at Graham, column 2, lines 19-21 to have a molecular weight of 7000. Applicant's claims 1-3 recite the polyol of their first components as having a weight average molecular weight of from 250 to 5,000. Applicant submits that Graham's Example 2, therefore, is not an anticipating disclosure." It is noted Example 2 of Graham does teach a polyol having a molecular weight outside of the claimed range such that Example 2 is not anticipating. However, as previously noted, Graham teaches using polyol molecular weights in the range of 2,000 to 15,000 (Column 2, lines 37-39), and Graham teaches the prepolymer content in the final adhesive is 30-60% and the additional polyol content is 5-70% (Column 3, lines 44-45 and 61-62), i.e. the weight ratio of prepolymer to the polyol is disclosed as in the range from 9/1 to 1/9, such that the disclosure of Graham anticipates the claim. Furthermore, as previously noted, it would have been obvious to one of ordinary skill in the art at the time the invention was made to admix the prepolymer and additional polyol within the specified ranges in order to provide a useful reactive hot melt in Graham as the ordinary artisan would have been expected to experimentally determine the optimum ratio for a given property and adhesive being manufactured.

Applicant further argues, "Further, claims 1-3 recite the polyol of the first components as having a weight average molecular weight of from 250 to 5,000. Graham discloses molecular weights in the range of 2000 to 15,000 with the best commercially available polyester having a molecular weight of 7,200, but states that "if a lower molecular weight hydroxyl terminated polyester is used, i.e., one with a molecular weight of 3600 ... the viscosity of the resulting prepolymer is too high for efficient mixing..." (Graham, page 4, lines 19-22), thus points out the inapplicability of a first component polyol molecular weight of 3600 to Graham's own method and further fails to provide enablement of such a molecular weight in his process, thereby teaching away from the lower molecular weights claimed by applicant." It is noted the Examiner responded to these arguments in the previous Office Action (See paragraph 5).

Applicant further argues, "The examiner now suggests that Graham points toward optimum molecular weights including at least 3,601 to 5,000. There is no support for this supposition within Graham; the inapplicability of a molecular weight of 3,600 falls far short of suggesting that 3,601 would be efficacious - there is no such suggestion within Graham and Graham's comment that the polyester molecular weight can be too high falls far short of suggesting 5,000 as a possible upper limit, particularly since Graham indicates, as above, that a polyester of molecular weight 7,200 is the best commercially available polyol, and that a molecular weight of 15,000 "will work as well". Applicant respectfully submits that the examiner is relying on applicant's own disclosure and thereby providing much too quantitative a reading of Graham's disclosure." It is noted Graham expressly discloses "The 7200 molecular weight is the best commercially available polyester although molecular weights in the range of 2,000 to 15,000 will work as well" (Column 2, lines 36-38). Thus, Graham specifically discloses using molecular weights within applicants claimed range (2,000 - 5,000) such that Graham clearly anticipates the claimed molecular weight limitation.


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